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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,647	07/17/2001	Ramachandran Murali	UPN-3963	3796
7278	7590	12/28/2007	EXAMINER	
DARBY & DARBY P.C.			CLOW, LORI A	
P.O. BOX 770			ART UNIT	
Church Street Station			PAPER NUMBER	
New York, NY 10008-0770			1631	
			MAIL DATE	DELIVERY MODE
			12/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/720,647

Applicant(s)

MURALI ET AL.

Examiner

Lori A. Clow, Ph.D.

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 6-26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) 9-24 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-8, 25, 26, and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **SUPPLEMENTAL DETAILED ACTION**

**This action is Supplemental to and replaces the Office Action sent 1 November 2007.**

The Examiner apologizes for any inconvenience to Applicant. Upon further consideration, the previous action has been deemed erroneous for the requirement for restriction set forth. As was noted in the previous Office Action, the previous Examiner had required, throughout prosecution, as restriction requirement upon allowance of the independent claim.

Applicants' response, filed 10 August 2007, has been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 1, 6-26, and 28-32 are currently pending. Claims 2-5 and 27 have been cancelled. Claims 9-24 and new claim 32 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 16 August 2004. Claims 1, 6-8, 25, 26 and 28-31 are examined herein.

It is noted that upon further consideration of the instant claims, the indication of allowable subject matter (claims 6-8, 25, 28 and 31) is hereby withdrawn.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6-8, 25, 26, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the program user's guide for DOCK (Version 4.0; Regents of the University of California (1998); pages 1-120 Edited by Todd Ewing) in further view of Takasaki et al. (Nature Biotechnology (1997) Vol. 15: pages 1266-1270; PTO form 1449). *This is a new grounds of rejection.*

Instant claim 1 is drawn to a method of identifying a compound that modulates intermolecular interaction between a functionally critical site of a target protein and a modifier

including identification of a cavity that is a distance from the critical site; calculation of cavity dimensions and mapping chemical or electrostatic properties; using dimension to identify compounds that have a functional group that can accommodate the cavity; and assay compounds in vitro. Claims 26 and 28-30 are drawn to identifying a compound that is an allosteric modifier.

In regard to claims 1, 6-8, and 25, 26, and 28-31, the DOCK program User's Guide teaches a program in which favorable orientations of a ligand in a receptor may be elucidated. A potential site of interest on the receptor is identified, often the active site. Points are identified within the site where ligands may be located. Sphere centers are identified by generating a set of overlapping spheres to fill the site. The sphere centers capture shape characteristics of the active site (or site of interest). Distances are calculated and shape scoring functions utilized (or binding energy functions) for ligand orientation (page 11, introduction). Further, critical points may be identified in which multiple critical sites are identified (page 21, user's guide). Similarity screens may also be performed to identify all molecules in a database which may be similar to a particular molecule of interest that has been elucidated (page 45, user's guide).

DOCK does not specifically teach identification of compound that modulates intermolecular interaction between what is called a functionally critical site of a target protein and a modifier. However, Takasaki et al. teach structure based design and characterization of an inhibitor of TNF $\alpha$  binding to its receptor. Takasaki teaches the notion of three critical binding sites of the TNF-receptor to which TNF $\alpha$  binds based upon crystal structures of receptor complexes (page 1266, column 2). Small molecule peptidomimetics were designed that were antagonists. In vitro assays were performed for verification (page 1267, column 2). Takasaki et al. were able to demonstrate that that one site in particular, WP9, was critical to antagonize

TNF $\alpha$  activity. This particular site is different from the authentic receptor (page 1269, column 1). Further mutation studies and antigenic epitope mapping were used to assign functions to particular regions of the TNF $\alpha$  molecule. Studies indicated that a contact site proximal to the transmembrane is critical.

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to have used DOCK cavity mapping of in the design of peptidomimetic inhibitors, as was done by Takasaki, as all the claimed elements were known in the prior art. Further, one of skill in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention.

No claims are allowed.

### **Inquiries**

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (571) 272-0715. The examiner can normally be reached on Monday-Friday from 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

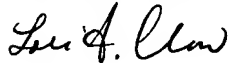
Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are

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available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

LORI A. CLOW, PH.D.  
PRIMARY EXAMINER



December 3, 2007  
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